

## **REMARKS**

Applicants respectfully request reconsideration of the present Application. Claims 1, 18, and 20 have been amended herein. Support for this amendments may be found, at least, at FIGS. 3A and 3B and ¶¶ [0035]-[0041] of the present application. Care has been exercised to introduce no new matter. Claims 1, 3-7, 10, 12-23, 26-50 are pending and are in condition for allowance.

### **Rejections based on 35 U.S.C. § 103(a)**

#### **A.) Applicable authority**

To sustain a rejection of a claim under 35 U.S.C. § 103(a), the Examiner must find that a preponderance of the evidence supports a finding of obviousness. The Examiner bears the initial burden of showing that the reference teachings establish a prima facie case of obviousness. “In view of all factual information, the examiner must . . . make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” MPEP § 2142 (explaining that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious”). In making that determination, the Examiner must consider every word in each claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Recently, the Supreme Court indicated that “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art . . . to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR*

*v. Teleflex*, 127 S. Ct. 1727 (2007). However, if the references do not “expressly or impliedly suggest the claimed invention,” the examiner must present “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP § 706.02(j) and § 2142, quoting *Ex parte Clapp*, 227 USPQ 972, 972 (Bd. Pat. App. & Inter. 1985).

**B.) Obviousness rejection based on U.S. Patent No. 6,698,020 to Zigmond in view of U.S. Patent No. 7,185,353 to Schlack is improper because certain claim limitations were not examined and thus no prima facie case of obviousness was made**

Claims 1, 3-7, 10, 12-23, 26-34, 36-42, and 44-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond (hereinafter the Zigmond reference) in view of U.S. Patent No. 7,185,353 Schlack (hereinafter the Schlack reference). Applicants submit that the Office Action failed to submit a prima facie case of obviousness in rejecting the claims, as the Office Action failed to consider the limitation that the transmission schedule “is sent to the individual network device in advance of the one or more promotions being received by the individual network device.” As independent claims 1 and 20 both recite this limitation, a prima facie case of obviousness has not been established.

Independent claim 1, as amended herein, is generally directed to a system for targeting promotions to an individual network device. The system includes a scheduler which generates a transmission schedule for the transmission of one or more promotions to an individual network device. The transmission schedule specifies when and how the individual network device is to receive the one or more promotions, preparing the individual network device to receive the one or more promotions in advance of the one or more promotions being received by the individual network device. The transmission schedule is generated for the

individual network device by matching i) a viewership profile generated from viewer usage data collected from the individual network device with ii) a membership criteria which describes a particular demographic, viewership history, or geographic location. The transmission schedule is sent by the scheduler to the individual network device in advance of the one or more promotions being received by the individual network device. The system also includes a promotion agent subsystem, located at the individual network device, that receives the transmission schedule from the scheduler, wherein the promotion agent collects the viewer usage data from the individual network device and processes the transmission schedule to receive the one or more promotions. The system further includes a life-cycle manager that receives the viewer usage data collected from the promotion agent subsystem and generates the viewership profile. The scheduler instructs a bulk manager server to retrieve the one or more promotions from a database and how to send the one or more promotions retrieved to the individual network device in a manner that the individual network device receives the one or more promotions according to the transmission schedule generated.

Independent claim 20 is generally directed to a method for targeting promotions to an individual network device. The method includes generating a transmission schedule for the transmission of one or more promotions to an individual network device. The transmission schedule specifies when and how the individual network device is to receive the one or more promotions, preparing the individual network device to receive the one or more promotions in advance of the one or more promotions being received by the individual network device. The transmission schedule is generated for the individual network device by matching i) a viewership profile generated from viewer usage data collected from the individual network device with ii) a

membership criteria which describes a particular demographic, viewership history, or geographic location. The transmission schedule is sent to the individual network device in advance of the one or more promotions being received by the individual network device. The method further includes sending the one or more promotions to the individual network device based on the transmission schedule. The method still further includes instructing a bulk manager server to retrieve the one or more promotions from a database and how to send the one or more promotions retrieved to the individual network device in a manner that the individual network device receives the one or more promotions according to the transmission schedule generated.

Applicants submit that the Office Action failed to address the limitations underlined above. Similarly, the Office Action failed to assert how the proposed combination of references discloses this limitation. It is axiomatic that the U.S. Patent and Trademark Office “must consider all claim limitations when determining patentability of an invention over the prior art.” *See, e.g., In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983); *see also In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Simply put, the Office Action failed to address how any construed transmission schedule is sent to a construed individual network device in advance of the one or more promotions being received by the individual network device. As the Office Action failed to consider the above-identified claim limitations, Applicants submit that a prima facie case of obviousness has not been established. As such, Applicants respectfully request withdrawal of the rejections recited in the Office Action and allowance of the rejected claims.

Moreover, Applicants note that any future rejection of the pending claims will necessitate new grounds for rejection—to supplant the deficiency of the present Office Action.

Applicants further note that any new grounds for rejection would not be necessitated by Applicants' amendment of claim 1 or based on information submitted in an information disclosure statement. As such, Applicants submit that any subsequent Office Action should not be made final. *See* MPEP 706.07(a).

C.) **Obviousness rejection based on the Zigmond reference in view of the Schlack reference is improper because the proposed combination fails to disclose, at least, the unexamined limitation**

Applicants submit that the proposed combination fails to disclose at least the above-discussed claim limitation. As previously detailed, independent claim 1, as amended herein, is generally directed to a system for targeting promotions to an individual network device. The system includes a scheduler which generates a transmission schedule for the transmission of one or more promotions to an individual network device. The transmission schedule specifies when and how the individual network device is to receive the one or more promotions, preparing the individual network device to receive the one or more promotions in advance of the one or more promotions being received by the individual network device. The transmission schedule is generated for the individual network device by matching i) a viewership profile generated from viewer usage data collected from the individual network device with ii) a membership criteria which describes a particular demographic, viewership history, or geographic location. The transmission schedule is sent by the scheduler to the individual network device in advance of the one or more promotions being received by the individual network device. The system also includes a promotion agent subsystem, located at the individual network device, that receives the transmission schedule from the scheduler, wherein the promotion agent collects the viewer usage data from the individual network device and processes the transmission schedule to

receive the one or more promotions. The system further includes a life-cycle manager that receives the viewer usage data collected from the promotion agent subsystem and generates the viewership profile. The scheduler instructs a bulk manager server to retrieve the one or more promotions from a database and how to send the one or more promotions retrieved to the individual network device in a manner that the individual network device receives the one or more promotions according to the transmission schedule generated.

Also as previously addressed, independent claim 20 is generally directed to a method for targeting promotions to an individual network device. The method includes generating a transmission schedule for the transmission of one or more promotions to an individual network device. The transmission schedule specifies when and how the individual network device is to receive the one or more promotions, preparing the individual network device to receive the one or more promotions in advance of the one or more promotions being received by the individual network device. The transmission schedule is generated for the individual network device by matching i) a viewership profile generated from viewer usage data collected from the individual network device with ii) a membership criteria which describes a particular demographic, viewership history, or geographic location. The transmission schedule is sent to the individual network device in advance of the one or more promotions being received by the individual network device. The method further includes sending the one or more promotions to the individual network device based on the transmission schedule. The method still further includes instructing a bulk manager server to retrieve the one or more promotions from a database and how to send the one or more promotions retrieved to the individual network

device in a manner that the individual network device receives the one or more promotions according to the transmission schedule generated.

By way of contrast, the Zigmond reference discloses a method and system for selecting and inserting advertisements into a video programming feed at the household level. Zigmond, Abstract. The Zigmond reference teaches that a number of advertisements are “periodically” delivered to an ad insertion device. *See, e.g., id.* at col. 10, ll. 16-22. These delivered advertisements are stored in preparation for selection and display. *See, e.g., id.* The Zigmond reference teaches an alternative embodiment wherein “preinstalled initial ad selections rules are included in new ad insertion devices and the associated home entertainment systems.” *See, e.g., id.* at col. 12, ll. 1-14. Applicants note that the Office Action construed the event triggers, ad selection rules/criteria, and ad parameters of Zigmond to disclose the claimed “transmission schedule.” Office Action, pp. 6-7.

Neither of these teachings disclose the invention embodied in claims 1 and 20. In one example, Zigmond teaches that the advertisements are delivered prior to the construed transmission schedule or else the ad selection rules would have no advertisement to select. In an alternative example, where the selection rules are preinstalled, Zigmond does not teach that the construed transmissions schedule is generated by the construed scheduler, as claimed. Thus, Zigmond fails to disclose, at least, these features of the claimed transmission schedule.

Likewise, the Schlack reference fails to teach or suggest all the limitations of independent claims 1 and 20. The Schlack reference discloses a system and method for scheduling advertisements in a television service network environment. Schlack, Abstract. The Schlack reference discloses an ad scheduler that generates a schedule for ads that are inserted

into the avails of a presentation stream. *See, e.g., id.* at FIG. 2; col. 5, ll. 58-67. The ad scheduler of Schlack is included as part of a larger advertisement delivery system. *See, e.g., id.* at FIG. 7; col. 8, ll. 5-67. As part of the ad delivery system, Schlack discloses a multiple presentation stream (MPS) generator that receives a presentation stream and “inserts appropriate ads . . . according to the ad schedule provided by the ad schedule.” *See, e.g., id.* at FIG. 7; col. 9, ll. 30-52. Then the ads, as part of a presentation stream, are transmitted to the subscribers. *See, e.g., id.* at FIG. 7. As such, the Schlack reference fails to disclose, at least, the claimed transmission schedule that “is sent by the scheduler to the individual network device in advance of the one or more promotions being received by the individual network device.” The Schlack reference simply fails to disclose sending the ad schedule to any individual network device. Moreover, the Schlack reference simply fails to disclose sending an ad schedule to any individual network device in advance of sending one or more promotions. As such, the Schlack reference fails to cure the deficiency of the Zigmond reference.

In view of the foregoing, Applicants submit that the Zigmond reference in view of the Schlack reference fails to teach or suggest all the limitations of independent claims 1 and 20. Accordingly, Applicants respectfully request withdrawal of all § 103(a) rejections regarding these claims. Further, each of claims 3-7, 10, 12-19, 21-23, and 26-50 depend, either directly or indirectly, from one of allowable independent claims 1 or 20. Therefore, claims 3-7, 10, 12-19, 21-23, and 26-50 are patentable for at least the reasons identified above with reference to claims 1 and 20. *See* MPEP § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”). Moreover, each of claims 3-7, 10, 12-19, 21-23, and 26-50 recite other novel and nonobvious features neither taught nor suggested in the



cited references in the context of these claims. Accordingly, Applicants respectfully request withdrawal of all § 103(a) rejections regarding claims 3-7, 10, 12-19, 21-23, and 26-50. These claims are believed to be in condition for allowance and such favorable action is respectfully requested.

**D.) Claim 1, as amended herein, is further patentable over the Zigmond reference in view of the Schlack reference because the combination fails to teach or suggest each limitation of the amended claim.**

Again, independent claim 1, as amended herein, is generally directed to a system for targeting promotions to an individual network device. The system includes a scheduler which generates a transmission schedule for the transmission of one or more promotions to an individual network device. The transmission schedule specifies when and how the individual network device is to receive the one or more promotions, preparing the individual network device to receive the one or more promotions in advance of the one or more promotions being received by the individual network device. The transmission schedule is generated for the individual network device by matching i) a viewership profile generated from viewer usage data collected from the individual network device with ii) a membership criteria which describes a particular demographic, viewership history, or geographic location. The transmission schedule is sent by the scheduler to the individual network device in advance of the one or more promotions being received by the individual network device. The system also includes a promotion agent subsystem, located at the individual network device, that receives the transmission schedule from the scheduler, wherein the promotion agent collects the viewer usage data from the individual network device and processes the transmission schedule to receive the one or more promotions. The system further includes a life-cycle manager that receives the viewer usage data collected

from the promotion agent subsystem and generates the viewership profile. The scheduler instructs a bulk manager server to retrieve the one or more promotions from a database and how to send the one or more promotions retrieved to the individual network device in a manner that the individual network device receives the one or more promotions according to the transmission schedule generated.

Applicants submit that the combination of the Zigmond reference in view of the Schlack reference fails to disclose each and every limitation of amended claim 1. For example, the Zigmond reference discloses a method and system for selecting and inserting advertisements into a video programming feed at the household level. Zigmond, Abstract. The Office Action construed the video switching device of Zigmond to disclose the claimed “promotion agent subsystem.” Office Action, p. 8. Applicants note that given this construction supplied in the Office Action, Zigmond fails to disclose each and every limitation of amended claim 1. The construed promotion agent subsystem of Zigmond does not collect the viewer usage data from the individual network device, as recited in amended claim 1. Applicants note that this assumes, *arguendo*, that the disclosed statistics collection reads on the claimed viewer usage data collection. Obviously, Applicants are merely pointing out at least one difference between the claimed invention and the Zigmond reference and not detailing each and every difference. As such, Zigmond fails to disclose, at least, a promotion agent subsystem that “collects the viewer usage data from the individual network device.”

Applicants submit that the Schlack reference fails to cure this deficiency of Zigmond. Applicants note that in the Office Action the Schlack reference was not cited as disclosing the claimed “promotion agent subsystem.” As the Schlack reference fails to disclose

the claimed promotion agent subsystem, the Schlack reference must fail to disclose the claimed promotion agent subsystem that collects the viewer usage data from the individual network device.

Similarly, Applicants submit that combination of the Zigmond reference in view of the Schlack reference fails to disclose the claimed “life-cycle manager that receives the viewer usage data collected from the promotion agent subsystem and generates the viewership profile.”

Based on the foregoing, combination of the Zigmond reference in view of the Schlack reference fails to disclose each and every limitation of amended claim 1. As such, the combination of Zigmond in view of Schlack fails must fail to support a case of obviousness of amended claim 1. Thus, amended claim 1 is patentable over the cited references of record and Applicants respectfully request allowance of the same.

Further, Applicants submit that each of claims 3-7, 10, 12-19, 33, and 35-45 depend, either directly or indirectly, from allowable independent claim 1. Therefore, claims 3-7, 10, 12-19, 33, and 35-45 are patentable for at least the reasons identified above with reference to claim 1. *See* MPEP § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”). Applicants submit that each of claims 3-7, 10, 12-19, 33, and 35-45 recite other novel and nonobvious features neither taught nor suggested in the cited references in the context of these claims. Accordingly, Applicants respectfully request withdrawal of all § 103(a) rejections regarding claims 3-7, 10, 12-19, 33, and 35-45. These claims are believed to be in condition for allowance and such favorable action is respectfully requested.

### **CONCLUSION**

For at least the reasons stated above, claims 1, 3-7, 10, 12-23, 26-50 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [ahankel@shb.com](mailto:ahankel@shb.com) (such communication via email is herein expressly granted) – to resolve the same. Other than the \$490 extension fee discussed above, it is believed that no fee is due. However, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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